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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,769	03/09/2006	Makoto Numakawa	07A3825PCT	3001
7590 12/16/2010 Quinn Emanuel Urquhart Oliver & Hedges, LLP Koda/Androlia 10th Floor 865 S. Figueroa Street Los Angeles, CA 90007			EXAMINER	
			EIDE, HEIDI MARIE	
			ART UNIT	PAPER NUMBER
			3732	
			MAIL DATE	DELIVERY MODE
			12/16/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/565,769

Filing Date: March 09, 2006

Appellant(s): NUMAKAWA ET AL.

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William Androlia  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 12, 2010 appealing from the Office action mailed March 16, 2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 9-14

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

5,520,882	Brown	5-1996
5,165,503	Hoffman	11-1992
4,990,087	De Rocchis et al.	2-1991

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 12 the recitation of positively claiming the handpiece is inconsistent with the preamble. The applicant should clarify what subject matter the claim is drawn to, i.e. either the subcombination of the maintenance apparatus alone or the combination of the maintenance apparatus and the handpiece.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Brown (5,520,882).

Brown teaches a maintenance apparatus 30 for a medical handpiece 10 with a chucking structure for detachably chucking a holding rotary tool along an axis and a bearing for rotatably supporting the chucking structure along the axis (col. 3, ll. 20-23, col. 5, ll. 13-17) comprising a maintenance fluid supply nozzle fluidly connected to a second fluid supply, the design of the nozzle is capable of being detachable connected in the chucking structure in place of the rotary tool so that the maintenance fluid is fed through the nozzle into the chucking structure as illustrated in fig. 4. Brown does not specifically teach the device functioning as claimed, however, the nozzle connected to the fluid supply 30 is capable of being detachable connected to the chucking structure therefore the claimed limitations are met. Brown further teaches a first fluid supply 20 for feeding the maintenance fluid to the bearing of the handpiece as illustrated in fig. 2 (see abstract) and wherein the nozzle comprises an elongated nozzle having an outer diameter that is capable of being substantially equal to an outer diameter of a rotary tool and the elongated nozzle having one end portion capable of insertion into a chucking structure and another end portion being coupled to the second fluid supply.

Claims 9-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman (5,165,503).

Hoffman teaches a maintenance apparatus comprising a maintenance fluid supply nozzle 248 capable of being fluidly connected to a second fluid supply, the supply nozzle being capable of being detachably connect in a chucking structure in place of a rotary tool so that a maintenance fluid is fed through the nozzle into the chucking structure. Hoffman further teaches a first fluid supply capable of feeding the maintenance fluid to a bearing of a handpiece (col. 6, ll. 17-21), a connector 52 which is designed to be detachable connect to a handpiece (fig. 2), the connector having a feeding passage 42 of the first fluid supply capable of feeding the maintenance fluid passage 55 of the second fluid supply capable of feeding the maintenance fluid through the nozzle of a chucking structure, wherein the connector has a recycling passage 56 which is capable of being detachably connected to a feeding passage of a handpiece and a handpiece having a recycling passage 18 which is capable of being detachably connected to the first feeding passage (col. 6, ll. 17-21, ll. 28-30), wherein when a handpiece is connected to the connector a maintenance fluid can be fed though the feeding passages of the connector and a handpiece to a bearing of a handpiece and then collected together with the maintenance fluid fed through the supply nozzle through the recycling passages of the connector and a handpiece. Hoffman further teaches the maintenance fluid supply nozzle comprising an elongated nozzle capable of having an outer diameter substantially equal to an outer diameter of a rotary tool, the elongated nozzle having and end portion capable for insertion into a chucking and another end portion capable of being coupled to a second fluid supply. Hoffman does not specifically

teach the apparatus functioning as claimed, however, the apparatus is capable of functioning as claimed; therefor the claimed limitations are met.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman 5,165,503 as applied to claims 9-12 above, and further in view of De Rocchis et al. (4,990,087).

Hoffman teaches the invention as substantially claimed and discussed above, however, does not specifically teach the nozzle having a hole for injecting the maintenance fluid in the form of a mist.

De Rocchis teaches the nozzle having a hole for injecting the maintenance fluid in the form of a mist (col. 3, ll. 38-41). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hoffman with the nozzle of De Rocchis in order to cover a larger area of the apparatus with the maintenance fluid and to conserve the fluid.

**(10) Response to Argument**

Appellant argues regarding the 112 second paragraph rejection that the claims are only drawn to the maintenance apparatus alone and should be interpreted and considered as such, however, claim 12 is positively claiming a handpiece with a

recycling passage, therefore, the claim language is not clear with respect to the appellant's statement that only the maintenance apparatus alone.

Appellant argues with respect to Brown the there is no suggestion or disclosure in Brown regarding the limitation of the nozzle being capable of being detachably connected to the chucking structure in place of the rotary tool and that Brown teaches the maintenance fluid is dropped onto the chucking structure with the rotary tool in place. Appellant further argues that there is no suggestion, showing or teaching in Brown that the diameter of the elongated nozzle would be equal to the outer diameter of the rotary tool. However, as the appellant has stated on the record, the handpiece and tool are not being claimed and only the maintenance apparatus is being claimed, therefore the maintenance apparatus taught by Brown only has to be capable of functioning as claimed and Brown does not have to provide a suggestion, showing or teaching of the apparatus functioning as claimed. It is well known in the art that dental handpieces are provided with a chucking structure to be able to removably retain a rotary tool. Therefore when a tool is removed from the chucking structure of a handpiece, a bore is located in the head of the handpiece, which was previously occupied by the tool. The nozzle taught by Brown, is capable of being inserted in the bore in the head of the handpiece, therefore the claimed limitations are met. With respect to appellant's arguments that Brown does not teach the diameter of the nozzle being equal in diameter to the rotary tool, it is noted that the manner in which the nozzle may relate in shape and dimension to that of the inferentially claimed tool is merely a matter of intended use of the device with a tool. It is held that the shown structure is

capable of having substantially the same external dimensions depending of the tool it is being used with.

Appellant argues with respect to Hoffman that an adapter connected to the handpiece is needed in order to lubricate and disinfect the handpiece, however for examination proposes, it is noted that the appellant is not claming the handpiece as discussed above in detail and the apparatus taught by Hoffman only needs to be capable of functioning as claimed. It is noted that the connector 52 is capable of being detachable connected to a handpiece, with or without an adaptor and the claimed limitations are still met if an adaptor is used since the adaptor would be part of the handpiece. Appellant further argues that Hoffman teaches the maintenance fluid is connected to the adapter and does not includes an elongated nozzle that can be inserted into the chucking structure in place of the rotary tool and that it is impossible for Hoffman to be capable of functioning as the claimed apparatus, particularly since Hoffman has no disclosure, suggestion or teaching that an elongated nozzle is inserted into the chucking structure in the place of the rotary tool. However, simply because Hoffman does not teach the apparatus functioning as claimed does not mean the apparatus is not capable of functioning as claimed. Hoffman teaches two different supply nozzles 48 and 14. As discussed in detail above with respect to a handpiece known in the art, a chucking structure is provided to be able to removably retain a rotary tool. Therefore when a tool is removed from the chucking structure of a handpiece, a bore is located in the head of the handpiece, which was previously occupied by the tool. The nozzle 48 taught by Hoffman, is capable of being inserted in the bore in the head of

the handpiece, therefore the claimed limitations are met. Appellant argues that Hoffman does not teach the claimed feeding passages feeding the bearing and the chucking structure, however, Hoffman teaches two different feeding passages as discussed in the office action. With respect to the functional limitations of the passages delivering the fluid to the bearing and the chucking structure, the apparatus taught by Hoffman only needs to be capable of delivering the fluid to those structures and depending on how the apparatus is applied to the handpiece, the fluid is capable of being delivered to the chucking structure and the bearings.

Appellant argues regarding the prior art of De Rocchis, that the nozzle taught by De Rocchis could be inserted into the chuck structure instead of the rotary tool, however, it is noted that De Rocchis is not used to teach this claimed limitation. The prior art of Hoffman is used to teach this limitation as discussed in detail above. De Rocchis is used to teach the limitation of delivering the fluid in the form of a mist which it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hoffman with the nozzle delivering the fluid in the form of a mist taught by De Rocchis in order to conserve the fluid.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Heidi M Eide/  
Examiner, Art Unit 3732

Conferees:

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732

/Thomas J Sweet/  
Supervisory Patent Examiner, Art Unit 3779